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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,551	12/12/2001	Jean-Pierre Pascault	CV-31583	2290
22202	7590	03/29/2004	EXAMINER	
WHYTE HIRSCHBOECK DUDEK S C			TESKIN, FRED M	
555 EAST WELLS STREET			ART UNIT	
SUITE 1900			PAPER NUMBER	
MILWAUKEE, WI 53202			1713	

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/937,551	Applicant(s) PASCAULT ET AL.	
	Examiner Fred M Teskin	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 20-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The response of December 23, 2003 has been fully considered with the effect that the 35 U.S.C.112/2d paragraph rejection of claims 1-28 and the 35 U.S.C. 102(b)/103(a) rejection of claims 1-19 are maintained as detailed below.

Claims 1-28 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 [and claims dependent thereon] are rendered indefinite by the recitation "Cardura E10 (meth)acrylate," for the reasons of record (see paper no. 8, page 2) and because the evidence and argument of record establishes that the term "Cardura E10" is a trade name that is intended to be used as a limitation in the claim to identify or describe a particular material or product. As evidence of the term being "a trade name of Shell, Japan Ltd.," examiner relies upon the Ogawa patent, cited herewith. (Ogawa, col. 3, lines 60-62.)

Applicants' arguments filed December 23, 2003, have been fully considered but are persuasive of error in the repeated rejection.

In view of applicants' stated intention to use the term "Cardura E10" as a limitation of methacrylate, there can be no doubt that the term is being used as limitation to identify or describe a particular material or product. Where a trade name is so used in a claim, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See, MPEP 2173.05(u) and case cited therein.

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Pointing to technical literature attached to the Amendment and an ACS registry number inserted in claim 1, applicants further argue that one skilled in the art knows that “Cardura E10” does represent a known chemical structure and product.

Applicants’ argument is not well taken. The fact that the term is a trade name means it identifies the *source* of a product and not the product itself. In consequence, the properties of the product, e.g., composition, may vary over time at the pleasure of the manufacturer and yet the product may continue to be sold under the same trade name. Thus, to the extent a particular composition is *currently* associated with “Cardura E10”, there can be no assurance that the same composition will *continue* to be sold under this trade name. In this regard, it is noted that the submitted data sheet on Cardura E10 describes the product as the glycidyl ester of Versatic 10 (presumably another trade name), which is described as a synthetic saturated monocarboxylic acid mixture of highly branched C₁₀ isomers. Obviously the isomeric make-up of the “mixture” is subject to change at the discretion of the manufacturer, resulting in a change in composition of the ester itself, and yet the product may continue to be sold under the same trade name.

Because of the possible variability of properties/composition of the product being sold under the trade name “Cardura E10,” the term cannot properly be used to particularly point and distinctly claim any particular (meth)acrylate ester.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2178048 A ("Ricoh").

The basis of the rejection is adequately set forth in the previous Office action (paper no. 8, pages 3-4) and that explanation is incorporated herein by reference.

Applicants' arguments filed December 23, 2003 have been fully considered but are not persuasive of error in the repeated rejection.

Applicants argue that given that the allylic(meth)acrylate is expressly excluded in claim 1, the novelty objection (rejection?) is not founded.

Examiner disagrees that the express exclusion of "an allylic(meth)acrylate" from the composition of claim 1 excludes the monomers B-4, B-6 and B-9 of Ricoh, as these monomers do not contain an "allylic" group, as that term is ordinarily defined in the art.

Specifically, since the term is not assigned any special meaning in the present specification, "allylic" is to be given its customary meaning in the art. As evidenced by the submission from the CRC Handbook, "allylic" signifies "the group $\text{CH}_2=\text{CHCH}_2-$ and

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derivatives *formed by substitution*" (page 2-39, emphasis added). Under this definition, the term "allylic(meth)acrylate" in claim 1 may properly be relied upon to exclude the monomer of Example 1 of Ricoh, which contains a $-C_3H_5$ ester group, as well as derivatives formed by substitution of the $-H$ atom(s) on that group, but not groups wherein the unsaturated site is present in a longer hydrocarbon chain such as the terminally unsaturated C_5 , C_9 or C_{16} groups described in Examples 2-4 of Ricoh. Indeed, applicants have pointed to no evidence of record to the contrary; i.e., that such C_5 , C_9 and C_{16} groups are recognized in the art as species of the "allylic" (meth)acrylate expressly excluded from claim 1.

Applicants further argue that the microparticles of Ricoh are not crosslinked during copolymerization but, rather, are crosslinked during a separate step.

Granting this assertion, the fact remains that the claims are drawn to the crosslinked microparticles of between 10 and 300 nm in size, obtained by polymerization of a composition of defined polymerizable compounds. (claim 1, lines 1-3.) That the microparticles of Ricoh may be crosslinked during a separate step, the ultimate product nonetheless meets the "crosslinked" limitation of claim 1, and there is no dispute that Ricoh describes a particle size between 10 and 300 nm. Moreover, the claims do not positively require crosslinking during polymerization, and in any case, are drawn to the microparticles *as a product* and not to the process by which they are prepared. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

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Applicants have not met their burden of showing that the claimed microparticles differ substantially from the microparticles of Ricoh as a result of the recited process (polymerization) step.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FMTeskin/03-22-04



FRED TESKIN
PRIMARY EXAMINER
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